

ATTACHMENT - REMARKS

By this Amendment, independent claim 1 has been rewritten as new independent method claim 130 for better clarity and to better define the invention, while independent system claim 52 have been amended for better clarity and to better define the invention. Other dependent claims have also been amended consistent with the changes to independent claims 130 or 52 and/or for clarity. It is submitted that the present application is in condition for allowance for the following reasons.

In the *Response to Applicant's Remarks/Amendments* section of the DETAILED ACTION, the examiner has generally criticized the method claims for having "functional recitations" (see last paragraph of page 3). However, it will be appreciated that the MPEP language which the examiner uses in support of this criticism is directed to the use of functional limitations in product or apparatus claims. By definition, a method claim is functional, requiring the recitation of functional "steps". Therefore, this criticism is misplaced insofar as method claims are concerned. However, for greater clarity and in accordance with US practice, it will be appreciated that the method claims have been revised to positively recite the various steps of the claimed method, which steps were somewhat indirectly recited in the original claims and may have been the source of the examiner's criticism. In particular, it will be appreciated as noted above that independent method claim 1 has been canceled and new independent method claim 130 is substituted therefor.

In this section, the examiner has also noted that the use of "when" in a claim is objectionable as being the use of "optional" language. However, in the context of the present claims, the use of "when" was not an optional usage, but rather a recitation of a

sequence and thus equivalent to the term "after" which is a frequently used limitation in method claims (as is "when", when employed for the same time-dependency, and not optional, usage). However, for better clarity, the term "after" is now used in the claims.

In the *Claim Rejections - 35 USC § 112* section of the Action, all examined claims were rejected as being indefinite. In particular, the examiner noted that independent method claim 1 was deficient for a number of reasons. As noted above, claim 1 has been canceled and new claims 130 substituted therefor. It is submitted that new claim 130 is definite and overcomes the noted issues.

In this section, the examiner also specifically objected to the use of "predetermined" as being a "relative" term. However, it is submitted that those of ordinary skill would readily appreciate what this term was meant to convey. For example, it is indicated in the specification that a SIM device (or other such device) can be used to provided the "predetermined" authentication information (see bottom paragraph of page 7 to the 1st full paragraph of page 9). Therefore, it is submitted that the rejection of the claims for use of the term "predetermined" in this context is not proper and should be withdrawn.

Specific rejections of claims 17 and 52 were also made in this section. By this Amendment, dependent claim 17 has been amended in a self-evident manner to overcome the noted rejection. In independent system claim 52, it is clear from the specification that the needed information can be provided by the user's telecommunication terminal or otherwise. Thus, the noted phrase is merely emphasizing this point, and such would be well appreciated by those of ordinary skill so the use of the noted phrase is not indefinite.

Therefore, in view of all of the above, it is submitted that the rejections for indefiniteness under § 112 has been overcome and should be withdrawn.

In the *Claim Rejections - 35 USC § 103* section, independent claims 1 and 52 and various noted claims dependent therefrom were all rejected under 35 USC § 103 as being obvious over Malinen (USPA 2003/0028763 to Malinen et al.). However, for the following reasons, it is submitted that these claims are all allowable over this reference.

With respect to new claim 130 which replaces claim 1, it will be appreciated as noted above that the various indirectly recited steps that the examiner previously ignored have now been positively and more particularly recited. Therefore, it is submitted that all of these steps as now presented are neither disclosed nor made obvious by Malinen.

With respect to both independent claims 1 and 52, the examiner also took "official notice" of the recitation in claim 1 (and 52) of

predetermined authentication [SIM] information stored by each authentication storage means corresponding to [SIM] information which is used to authenticate a telecommunications terminal of that user in relation to the telecommunications system but the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring use of that user's telecommunications terminal.

However, official notice is proper for a fact, and the assertion that such a fact is common knowledge of those of ordinary skill. The above quoted recitation is not a fact; and thus the official notice of this step of applicant's invention is challenged on that basis.

In addition, at the time of the invention (2003), the mobile telephony industry considered that a SIM was only a card that was ALWAYS to be associated with a suitable user terminal if it were to be used to authenticate transactions; and in particular

not that it was to be used or usable as a "general purpose" smart card. Thus, the official notice of this step of applicant's invention is also challenged on that basis.

Further, the Examiner's only "support" for his assertion of "official notice" is to point to the use of (general purpose?) smart cards with portable authentication means. This is not analogous to the use of a SIM card (with authentication credentials that would at the date of filing have been assumed to be useful ONLY in authenticating communication over a mobile telecommunications system) in a different authentication process. There is nothing in the prior art that suggests this "second use" of the SIM's authentication credentials.

Therefore, for all of the above reasons, the examiner's assertion of "official notice" of the recited claim language is in error and should be withdrawn.

And once withdrawn, the obvious rejection over Malinen of independent claims 1 (or rather new claim 130 now) and 52 is negated and should also be withdrawn.

Therefore, for all of the foregoing reasons, it is submitted that independent claims 130 and 52 are now allowable. And for at least these same reasons, it is submitted that rejected dependent claims 2, 5-7, 11-12, and 36-39 dependent from new independent claim 130 and dependent claims 53, 56-58, 61, and 85-88 dependent from independent claim 52 are also allowable.

It is further submitted that the remaining dependent claims 17, 19-20, 22-23, 25, 27, and 30-34 dependent from independent claim 130 and dependent claims 66, 68-69, 71-72, 74, 76, and 79-85 dependent from independent claim 52 rejected over Malinen and further in view of Tayloe or Tayloe and Schneier are likewise allowable for the same reasons as for independent claims 130 and 52 noted above.

For all of the foregoing reasons, it is submitted that the present application is in condition for allowance and such action is solicited.

Respectfully submitted,

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